Paper No. 19

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD J. GADD

Appeal No. 96-2616
Application 08/280,271[1]

ON BRIEF

Before KRASS, BARRETT and FRAHM, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 5, all of the claims pending in the application.

[1] Application for patent filed July 26, 1994.

The invention is directed to a method for displaying text in its context on a display screen in such a manner that eye contact is maintained with a line of text as the display changes to show the line in its context.

Independent claim 1 is reproduced as follows:

1. A method of displaying text on a physical display screen using a key word search, the text comprising a plurality of lines of characters, each line having said key word, from one or more data files, the method comprising the steps of:

(a) displaying the plurality of lines, each line having said key word, on the display screen;

(b) selecting one of the displayed lines having said key word; and

(c) displaying selected lines immediately preceding and immediately succeeding the selected line in the same data file in physical position above and below, respectively, the selected line and said key word, wherein the text of the selected line retains its physical position, both horizontally and vertically, on the physical display screen.

The examiner relies on the following references:

Inoue et al. (Inoue)	5,142,669	Aug. 25, 1992
Wroblewski et al. (Wroblewski)	5,339,391	Aug. 16, 1994 (filed Aug. 4, 1993)

APS Text Search & Retrieval Classroom Manual, Planning Research Corporation (June 1989) (APS).

Claims 1 through 5 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the

examiner cites APS in view of Inoue with regard to claims 1 through 4, adding Wroblewski to this combination with regard to claim 5.

Reference is made to the brief and answer for the respective positions of appellant and the examiner.

OPINION

We reverse.

APS is representative of the conventional systems wherein searched words or phrases are highlighted and a user moves through screens or windows looking for the highlighted words or phrases.

The instant invention improves upon the prior art by keeping the highlighted words or phrases fixed horizontally and vertically while displaying lines immediately preceding and succeeding the selected word or phrase or, as claimed, "the selected line," in a physical position above and below the selected line. Thus, the instant invention provides a method for maintaining eye contact with a line of text as the display is changed to show the line in its context.

Instant independent claim 1 includes this improvement by reciting:

> (c) displaying selected lines immediately preceding and immediately succeeding the selected line in the same data file in physical position above and below, respectively, the selected line and said key word, wherein the text of the selected line retains its physical position, both horizontally and vertically, on the physical display screen.

The examiner appears to recognize this difference between the instant claimed invention and the system disclosed by APS. However, the examiner cites Inoue for the teaching of a

selected portion of text being retained in its physical position and concludes that it would have been obvious

> to incorporate Inoue's retain the physical position of a text into APS's teachings of displaying selected line (word) in a file, in order to allow the APS system to retain certain part of the line or word in the file for future use [Answer-page 4].

First, while Inoue does disclose a "specified area to be displayed fixedly...," this disclosure refers to a scrollable window area of the display in Inoue wherein that window area scrolls in the same direction as, and with, text displayed outside the window area until the window reaches an end of the display at which time it becomes an unscrollable window area which is displayed fixedly on the display screen while text outside the window area continues to scroll. Thus, until the window area reaches the end of the screen, it is, in fact, moving with the text outside the window area and is not retained in a physical position, both horizontally and vertically, on the physical display screen, as required by the instant claims. Once the window area reaches the fixed position on the screen where it no longer scrolls, and assuming that this window area is analogous to the claimed "selected line," it cannot be said that selected lines are displayed "immediately preceding and immediately succeeding the selected line in the same data file in physical position above and below, respectively, the selected line...," as claimed.

We agree with appellant, at page 7 of the brief, where appellant states:

> What the *Inoue et al*. reference teaches is that although there is a fixedly displayed text section, it is not physically fixed on the screen, but is allowed to move left or right, up or down, depending upon the scrolling commands executed by the user.
>
> . . .
>
> Further, the unscrollable section, as denoted by S and E in Figure 2 of *Inoue et al*., translates up or down or left and right on the screen during the scrolling operation, which is in direct contradiction to the invention as claimed.

Moreover, even if Inoue could be considered as teaching a fixedly displayed text section as intended by, and set forth in, the instant claims, the examiner has presented us with no convincing evidence as to why the skilled artisan would have been led to make the combination. The system of APS apparently operated just fine with no indication that there was any problem which needed to be fixed, such as keeping the selected line in a fixed physical position of the display screen. With no apparent reason or indication that there would have been some advantage to keeping the selected line in a fixed physical position on the display screen, why would the artisan have been led to look to Inoue for some teaching of a text portion fixed in a physical position on the display screen in order to modify APS? We see no reason and the examiner has not supplied one other than "in order to allow the APS system to retain certain part of the line or word in the file for future use" [Answer-page 4]. However, the examiner never indicates why the APS system would want or need to "retain certain part of the line or word" nor of what "future use" the retained part would have.

The reference to Wroblewski, applied in the rejection of claim 5, is not seen to remedy the deficiencies of APS and Inoue.

We find that the examiner has failed to set forth a prima facie case of obviousness with regard to the instant claimed subject matter and, accordingly, we will not sustain the rejection of claims 1 through 5 under 35 U.S.C. 103.

The examiner's decision is reversed.

REVERSED

ERROL A. KRASS)
Administrative Patent Judge)
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LEE E. BARRETT) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES

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